



27 JUL 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

28

Joseph R. Carrier
Carrier, Blackman & Associates, P.C.
24101 Novi Road, Suite 100
Novi, Michigan 48375

In re Application of
FUJIMOTO et al.
U.S. Application No. 09/857,382
PCT No.: PCT/JP99/06675
Int. Filing Date: 30 November 1999
Priority Date: 03 December 1998
Attorney Docket No.: KNI-152-A
For: HYDROPHILLIC MEMBER

DECISION ON REQUEST
&
NOTIFICATION REGARDING
DEFECTIVE DECLARATION

This decision is in response to applicants' "Third Request for 'Updated' Filing Receipt" filed on 28 November 2003 and the facsimile communication dated 25 June 2004. No petition fee is required.

BACKGROUND

On 30 November 1999, applicant filed international application no. PCT/JP99/06675 which claimed a priority date of 03 December 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 June 2000. The international application named Hidefumi Fujimoto; Kazuo Takahashi; Koji Takeda; Keisuke Tanaka; Estuo Ogino; Kenji Mori; and Masahiro Hirata as applicants/inventors. A Demand was filed with the International Preliminary Examining Authority. As a result, the deadline for entry into the national stage in the United States expired 30 months from the priority date, on 03 June 2001.

On 01 June 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; and a preliminary amendment.

On 09 August 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 23 June 2001, applicants filed "Response Notification of Missing Requirements under 35 U.S.C. 371" which included a declaration executed by: Hidefumi Fujimoto; Kazuo Takahashi; and Koji Takeda.

On 09 August 2001, a Notification of Acceptance was issued identifying the 35 U.S.C. 371(c) date as 23 June 2001. Subsequently, an Official Filing Receipt was issued indicating a "FILING DATE" of 23 June 2001. The Official Filing Receipt listed Hidefumi Fujimoto; Kazuo Takahashi; and Koji Takeda as inventors for the above-identified application.

On 17 September 2001, applicants filed "Second Response Notification of Missing Requirements under 35 U.S.C. 371" which included a declaration executed by: Keisuke Tanaka; Estuo Ogino; Kenji Mori; and Masahiro Hirata.

On 28 November 2003, applicants' filed "Third Request for 'Updated' Filing Receipt."

DISCUSSION

Applicants state in the present request, "[i]n connection with the above-identified application, applicant once again respectfully requests an 'updated' filing receipt identifying all seven (7) inventors." However, a review of the application file and other Patent and Trademark Office records reveals that the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not been completed as indicated in the Notification of Acceptance mailed by the DO/EO on 09 August 2001. Specifically, the declarations filed on 23 June 2001 and 17 September 2001 are defective pursuant to 37 CFR 1.497(a)(3) which requires that the declaration "identify each inventor and the residence and country of citizenship of each inventor." Section 201.03 of the Manual of Patent Examining Procedure states, in part,

While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity . . . For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor . . .

In this case, the declaration filed on 23 June 2001 identified the first, second, and third and the declaration filed 17 September 2001 identified only the fourth, fifth, sixth and seventh inventor, which is improper. Thus, applicants are required to file a newly executed declaration which complies with 37 CFR 1.497(a) and (b). As such, the Notification of Acceptance of Application was erroneously mailed by the DO/EO/US and must be vacated.

CONCLUSION

Applicants' request for a corrected filing receipt is GRANTED.

Accordingly, the 31 January 2000 Notification of Acceptance of Application is hereby **VACATED**.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Defective Response (Form PCT/DO/EO/916) indicating that an oath or declaration is required. No extension of time will be allowed under 37 CFR 1.136.



Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459